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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,482	09/05/2003	W. Richard McCombie	021031-000113US	8702

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EXAMINER

LU, FRANK WEI MIN

ART UNIT PAPER NUMBER

1634

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/656,482	<b>Applicant(s)</b> MCCOMBIE ET AL.	
	<b>Examiner</b> Frank W. Lu	<b>Art Unit</b> 1634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 46-57 is/are pending in the application.
- 4a) Of the above claim(s) 48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 46,47 and 49-57 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                             |                                                                                         |
|---------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                 | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/2003</u> . | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of species (1) (randomly shearing in claim 48) in the reply filed on June 30, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 46, 47, and 49-57 will be examined.

### ***Oath/Declaration***

2. The oath or declaration is defective because newly added inventor, Pablo D. Rabinowicz is not listed in the oath or declaration.

### ***Drawings***

3. Some areas in Figures 3A to 3D and Figure 9 are not observable. Applicant is required to submit new Figures 3A to 3D and Figure 9 in response to this office action.

### ***Specification***

4. The amendment filed on September 5, 2003 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material "the disclosures of U.S. Patent Application No. 09/713,426 are hereby specifically incorporated by reference" in page 2 of the amendment is not supported by

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the original disclosure because original filed specification does not describe to specifically incorporate U.S. Patent Application No. 09/713,426 by reference.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. For example, see page 18, second paragraph and page 19, first paragraph. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

6. The disclosure is objected to because of the following informality: BRIEF DESCRIPTION OF DRAWINGS describes Figures 4A and 4B. However, applicant only provides Figure 4.

Appropriate correction is required.

### ***Claim Objections***

7. Claim 46 is objected to because of the following informality: “a eukaryotic genome” in lines 2, 4, 13, and 14 should be “an eukaryotic genome”.

8. Claim 47 is objected to because of the following informality: “A method” should be “The method”.

9. Claim 55 is objected to because of the following informality: “maize, rice, Brassica, soybean, and wheat” should be “maize genome, rice genome, Brassica genome, soybean genome, and wheat genome”.

10. Claim 57 is objected to because of the following informality: “mammalian” should be “mammal genome”.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 46, 47, and 49-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. Claim 46 is rejected as vague and indefinite. Since it is known that Cot is the product of concentration of nucleic acid (ie., mols of nucleotide per liter) and time (ie., seconds), it is unclear what is the unit of Cot in claim 46. Please clarify.

14. Claim 46 recites the limitation “the non-repetitive population” in selecting step of the claim. There is insufficient antecedent basis for this limitation in the claim because there is no phrase “a non-repetitive population” before “the non-repetitive population”. Please clarify.

15. Claim 48 recites the limitation “the genomic DNA” in selecting step of the claim. There is insufficient antecedent basis for this limitation in the claim because there is no phrase “genomic DNA” in claim 46. Please clarify.

16. Claim 50 recites the limitation “said genomic DNA” in selecting step of the claim. There is insufficient antecedent basis for this limitation in the claim because there is no phrase “genomic DNA” in claim 46. Please clarify.

***Conclusion***

17. No claim is allowed.

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18. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is (571)273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571)272-0735.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

September 18, 2006



FRANK LU  
PRIMARY EXAMINER